

IN THE CLAIMS:

Please REPLACE claim 4 with the following AMENDED claim 4.

4.(TWICE AMENDED) The recording medium of claim 3, wherein the recording medium indicates a write protection state when writing protection information from one of the plurality of physically separate locations matches writing protection information read from another one of the physically separate locations.

REMARKS

INTRODUCTION:

In accordance with the foregoing, claim 4 has been amended. Claims 1-8 are pending and under consideration. No new matter is presented herein.

INFORMATION DISCLOSURE STATEMENT:

The outstanding Office Action has indicated that the foreign references cited in the Information Disclosure Statement, filed December 19, 2001, have not been considered since copies of the references cited therein were not supplied therewith. Applicants concurrently file herewith a Communication to the Examiner Forwarding Foreign References, including copies of these foreign references with a clean copy of the PTO-1449 Form. Applicant respectfully requests reconsideration of the same.

ENTRY OF AMENDMENT:

It is respectfully requested that this After Final Amendment be entered and reconsideration given to the allowability of the pending claims. Claim 4 has been amended as required in the previous Office Action. According to the MPEP, amendments to the claims to correct for errors in the claims, e.g., §112 issues, which should have been anticipated should be entered and considered in an After Final Amendment.

Therefore, entry and reconsideration of the allowability of the pending claims is respectfully requested.

REJECTIONS UNDER 35 USC §112:

Claim 4 stands rejected under 35 USC §112, second paragraph for defining the invention of the same using method language. Claim 4 has been amended, without narrowing the same, to more clearly define the invention of claim 4 without method language.

Therefore, for at least the above, it is respectfully requested that this rejection be withdrawn.

REJECTION UNDER 35 USC §102/103:

Claims 1, 2 and 8 stand rejected under 35 USC §103(a), being obvious over either Ko et al., EP-1052639, or Kuroda et al., U.S. Patent No. 5,946,277, in view of Ro et al., U.S. 6,288,989. This rejection is respectfully traversed.

First, it is noted that the present application claims both foreign and domestic priority from as early as June 15, 1998, and June 15, 1999, respectively. Whereas Ko et al. has a publication date of November 15, 2000. Therefore, Ko et al. is not a proper §102 reference and cannot be used to reject the present invention under §103.

The Office Action further sets forth that Kuroda et al. discloses all the claimed features except for the "desired ability of having write protection information stored accordingly," and then utilizes Ro et al. to disclose "the ability of having write protection in this environment. It appears from the description that the write protection information is in the lead in area of the disc."

By way of review and as an example, independent claim 1 sets forth a recordable and/or rewriteable recording medium to record data, including a lead-in area, a lead-out area, and a user data area. The recording medium stores write protection information in an RMD (Recording Management Data) field of an RMA (Recording Management Area) area to protect the data recorded on the recording medium from unwanted overwriting or erasing.

The present application defines the claimed RMA as "including general information relating to recording, i.e., information about the recording mode of a disc, recording state, optimal power control and border zone." See the present specification on page 14, paragraph [0063]. In addition, "FIG. 13 [of the present application] shows the content of an RMD (Recording Management Data) field of the RMA according to the DVD-R and DVD-RW specifications. The RMA comprises an RMA Lead-in area including a system reserved field (contents:00h) and a unique ID field, and **RMD** fields." See the present specification on

page 14, paragraph [0066].

Thus, the present specification sets forth specific definitions of the claimed RMD field as pertaining to DVD-R and/or DVD-RW specifications, and specifically defines the structure of the claimed RMD as being a particular field in the RMA.

The outstanding Office Action sets forth that Kuroda et al. reads information from an RMD area, and therefore inherently discloses the claimed RMA and RMD areas. Particularly, the Office Action recites: "[a]pplicants' use of the next term RMA and RMD DOES NOT DEFINE OVER Kuroda et al....Here the Examiner concludes that both the claimed RMA and RMD limitations [are] not only inherently present but merely a **colorful use of language that does not [patentably] distinguish over the document. As is well known, 'a rose by any other name would still smell as...'**"

The pending claims have particularly claimed features, which are to be interpreted in accordance with their usual meaning in the art and their particular definition in the specification. Thus, regardless of the Examiner's conclusion that the claimed features have no particular meaning, or that the claimed RMA and claimed RMD were merely "colorful" uses of language, the claims must be interpreted as defined.

As noted above, the claimed RMD is a particular field in the RMA, and the claims must be interpreted the same.

Further, the Office Action points out that Kuroda et al. uses the term RMD, which must of course be the same RMD recited in the present application and claims.

However, as illustrated in FIG. 9 of Kuroda et al. the recited "RMD" of Kuroda et al. would actually appear to be referring to the specifically defined Recording Management Area (RMA) of the present application. Kuroda et al. does not disclose the claimed Recording Management Data (RMD) field of the RMA, as defined in the present specification and recited in independent claim 1.

Further, the Office Action indicates that the claimed RMA and RMD must be inherently disclosed in Kuroda et al. However, "when an examiner relies on inherency, it is incumbent on the examiner to point to the 'page and line' of the prior art which justifies an inherency theory." Ex parte Schricker, 56 USPQ2d 1723 (BdPatApp&Int 2000). The Office Action has failed to point to passages of Kuroda et al. which support the conclusion of this inherency. Rather, such an inherency can not be supported because Kuroda et al. would not appear to disclose the

claimed RMD field.

Thereafter, the Office Action points out that the particular placement of write protection information in the RMD is merely a "relocation of this signal" and "MERELY A DESIGN CHOICE and obvious to one of ordinary skill in the art....Placement of such information in a MANAGEMENT AREA is logical. Placement of this Management Area in applicants termed - RMA is equally logical."

However, it is pointed out that "[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

Thus, as pointed out in the Office Action, there is no available evidenced motivation for modifying Kuroda et al. to place write protection information in an RMD field of the disclosed Recording Management area.

Rather, the Office Action indicates that such a modification would be merely a design choice.

Regarding this "design choice" premise, it is improper to base a rejection on the claimed feature being merely a design choice. See *In re Garrett*, 1986 Pat. App. LEXIS 8 (Bd. Pat. App. 1986), where the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences ("Board") specifically stated: "the examiner has not presented any line of reasoning as to why the artisan would have been motivated to so modify the...structure, and we know of none. The examiner's assertion...that the proposed modification would have been "an obvious matter of engineering design choice well within the level of skill of one of ordinary skill in the art" is a conclusion, rather than a reason." Similar discussions can be seen in *In re Chu*, 36 USPQ2d 1089 (Fed. Cir. 1985).

Thus, regardless of what the Office Action purports to be obvious, or merely a design choice, the same must be supported by evidenced motivation in the record providing a suggestion or motivation for such a modification of Kuroda et al.

Thus, for at least the above, it is respectfully submitted that the outstanding rejection fails to meet the required prima facie obviousness standard. Accordingly, it is respectfully requested that this rejection be withdrawn.

Claims 2, 3, 5, 6 and 8 stand rejected under 35 USC §103 as being obvious over the combination of Kuroda et al. or Ko et al., in view of Ro et al., and in further view of prior art set forth in the present application (Prior Art) and either McFerrin et al., U.S. Patent No. 5,142,515, or Curtis et al., U.S. Patent No. 5,233,576. This rejection is respectfully traversed.

First it is noted that the Office Action previously, in the above mentioned rejection, stated that claims 2 and 8 were disclosed by the combination of Kuroda et al. and Ro et al. Regardless, the following will address the present rejection as recited, addressing claims 2 and 8 as if the Office Action hadn't already deemed them obvious without the additional references.

The Office Action sets forth that particular claimed features of claims 2, 3 and 5 are disclosed in Prior Art. However, the Office Action sets forth no obviousness rationale for modifying the previous combination of Kuroda et al. and Ro et al. to include the same. Even though the features may be known, there still must be a recited motivation for modifying the combination of Kuroda et al. and Ro et al. to include the same.

Similarly, regarding the feature of claim 3, the Office Action also indicates that Curtis et al. discloses the claimed feature, again without reciting any motivation or rationale for modifying the combination of Kuroda et al. and Ro et al.

Again, regarding the claimed feature of claim 6, the Office Action points out that McFerrin et al. may disclose the claimed feature, but fails to provide any motivation or rationale for modifying the combination of Kuroda et al. and Ro et al.

Lastly, regarding the claimed feature of claim 8, the Office Action recites that it "would have been obvious to one of ordinary skill in the art to modify the 'base reference' of McFerrin et al. with the teaching(s) from the acknowledged Prior Art, motivation [being] to take [advantage] of existing disk formats available to those of ordinary skill in the art and therefore save valuable resources in reading invention limitations that already exist."

First, this rejection is not clearly understood since the purported base reference would be the combination of Kuroda et al. and Ro et al., not McFerrin et al. Regardless, the rationale for modifying Kuroda et al. and Ro et al. to include the features of McFerrin et al. and Prior Art is essentially the same as discussed above regarding the "design choice" argument of the Office Action regarding claim 1. Again, it is pointed out that regardless of the Office Action's opinion of whether something would have been a design choice or obvious, the Office Action must still set forth particular evidenced motivation or suggestions and supporting rationale upholding the

obviousness conclusion.

Therefore, for at least the above, it is respectfully requested that these rejections of claims 2, 3, 5, 6 and 8 be withdrawn and claims 2, 3, 5, 6 and 8 be allowed.

Claim 7 would appear to stand rejected under 35 USC §103 as being obvious over the combination of Kuroda et al. and McFerrin et al., in view of Prior Art. and McFerrin et al. This rejection is respectfully traversed.

The Office Action recites that claim 7 is rejected as being obvious over "the prior art as applied to claim 1, and further in view of McFerrin et al." However, claim 7 depends from claim 1, which has been rejected under the combination of Kuroda et al. and Ro et al. Therefore, this rejection will be interpreted as arguing that claim 7 is rejected under the rationale that it would have been obvious to modify the combination of Kuroda et al. and Ro et al. to include the claimed features of claim 7, based on the disclosures of Prior Art and McFerrin et al.

The Office Action points out that McFerrin et al. indicates that "different bytes in different segments are reserved for special features. Although no specific byte is designated as the write protect indicator, use of a designated byte for such a function is considered merely a selection of alternative equivalents," i.e., a design choice.

Similar to above, this "design choice" rationale is improper, as particularized motivation or suggestions, and supporting rationale, are required for a prima facie obviousness rejection.

Claim 7 would appear to stand rejected under 35 USC §103 as being obvious over the combination of Kuroda et al. and McFerrin et al., in view of Heo, U.S. Patent No. 6,392,969, or Maeda et al., 6,072,759. This rejection is respectfully traversed.

Similar to above, the Office Action indicates that it would have been obvious to modify the combination of Kuroda et al. and McFerrin et al. because it would have been merely a "design choice." However, again, such rationale is improper, as particularized motivation or suggestions, and supporting rationale, are required for a prima facie obviousness rejection.

Claims 1, 2 and 8 stand rejected under 35 USC §103 as being obvious over Kuroda et al. or Ko et al., in view of Nozaki et al., U.S. Patent No. 6,396,998. This rejection is respectfully traversed. ✓

Similar to above regarding the present applications claims for domestic and foreign priorities, Nozaki et al. was filed September 5, 2000, while the present application claims foreign and domestic priorities dating as early as June 15, 1998, and June 15, 1999, respectively. Therefore, Nozaki et al. is not a proper §102 reference and cannot be used in rejecting the present invention under a §103 rejection.

Therefore, it is respectfully submitted that this rejection, as well as the rejection of claims depending from independent claim 1, are moot. The withdraw of these rejection is respectfully requested.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

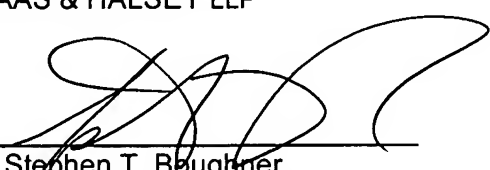
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 12/4/02

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please AMEND claim 4, as follows:

4. (TWICE AMENDED) The recording medium of claim 3, wherein the recording medium indicates a write protection state [wherein] when [the] writing protection information [read] from one of the plurality of physically separate locations matches [the] writing protection information read from another one of the physically separate locations[, the recording medium is indicated as being set to a write protection state].